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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,066	01/12/2001	Karl-Heinz Schuster	(Z) 99023 P US	3378

7590 12/04/2002
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EXAMINER

LESTER, EVELYN A

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,066

Applicant(s)

SCHUSTER, KARL-HEINZ

Examiner

Evelyn A. Lester

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,5-11,15,17-20,22-28 and 33 is/are rejected.
- 7) ☒ Claim(s) 2-4,12-14,16,21 and 29-32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: ____

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 5-14-99. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The reference document of "DE 198 55 158 A1" has not been considered because there is no date provided.

Specification

3. A substitute specification not including the claims is required pursuant to 37 CFR 1.125(a) because the pages of the specification are poor copies, in that most pages have missing and/or difficult to read text. Though the Examiner was able to ascertain the words, should this case become allowable, the publishing office will have difficulty reading the text.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the

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amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 23 and 24, there is no antecedent basis for “said vertex radius (R).”

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sasaya et al (U.S. patent 5,805,344).

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Sasaya et al discloses the claimed invention as shown in Figures 3 and 13, and their accompanying text, especially the data table beginning at column 26 to the fifth embodiment, wherein Sasaya et al's projection objective optical system has at least a first waist of a pencil of rays with a lens having an aspheric surface arranged after the first waist.

6. Claims 1, 5-11, 15, 25-27 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamaguchi et al (DE 198 18 444 A1).

Please note in Yamaguchi et al at Tables 3A and 3B, as well as pages 13-15; also note Tables 5A and 5B, as well as pages 19-21.

7. Claim 22 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Araki (U.S. patent 4,948,238).

Please note Araki's first and fifth embodiments at column 4, line 1 to column 6, line 58, and at column 11, line 30 to column 12, line 49, and especially the data tables in column 4 and column 11.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (DE 198 18 444 A1) in view of Sasaya et al (U.S. patent 5,805,344).

Yamaguchi et al discloses the claimed invention as described above, except for the specific materials as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the claimed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. In this case, Sasaya et al teaches that these materials are well known and useful for correcting chromatic aberration, as noted specifically at column 28, line 61 to column 29, line 2.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 5-10, 19, 23, 24 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-17 and 28 of copending Application No. 09/847,658 (US 2002/0008861 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the applications' claimed inventions are obvious variations of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

For example, with respect to claim 5 of the instant invention and specifically claims 8, 15 and 16 of the copending application, each of the applications discloses a projection objective optical system having an aspheric lens surface in relation to the first waist or correspondingly the respective "bulge."

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Allowable Subject Matter

12. Claims 2-4, 12-14, 16, 21 and 29-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to teach or fairly show the combination of claimed elements and claimed limitations of the indicated claims, wherein claims 2, 3 and 12 recite a particular placement of the aspheric lens surface; claim 4 recites the lens arrangement having only one lens having an aspheric surface; claim 13 recites the lens arrangement does not exceed a specific maximum lens diameter; claim 16 recites the lens arrangement has on the image side a numerical aperture of 0.8; claim 21 recites a specific lens group having a specific lens material; claim 29 recites a specific relation between the numerical aperture and the sine values; claim 31 recites a relationship between the maximum lens diameters of lens groups 3 and 5; and claim 32 recites an aspheric lens surface related to an angle loading of at least $\sin I=0.75$.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E.A. Lester whose telephone number is (703) 308-4943. The examiner can

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normally be reached on Monday-Friday from about 9:30 am to 6 pm (subject to an extended flex schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps, can be reached on (703) 308-4883. The fax number for Technology Center 2800 is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Evelyn A. Lester
Primary Examiner
AU 2873
December 2, 2002